

Remarks

Section 112

Claim 5 has been amended such that "the external timing block" is now claimed as "the external timing element". Claim 1 contains the support for the use of this term. This amendment should obviate the rejection of sections 1 and 2 of the Office action.

Section 102

The Office action found that applicants' claims 1-6 were anticipated by Shinohara. An analysis of the cited reference reveals that the elements claimed by the applicants are not found in the cited reference.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. V. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the . . . claim." *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim. *In re Bond*, 15 USPQ2d 1566 (Fed. Cir. 1990). The cited references fails to meet these legal standards for anticipation.

The applicants' claims as amended are directed to a system including a user interface for a user to set the system in one of two modes: either a first mode that uses the internal timing element to control the timing operation of the system or the second operating mode which bypasses the internal timing element to control timing operation in the system. Thus, a reference would teach every element of the claim only if it teaches an interface that is adapted by the user into one of two modes. However, this is not the case in the cited reference.

In the Related Background Art section of the cited reference, the disclosed purpose of the system is to allow reduced power consumption in an imaging system. In paragraph 14, this energy efficiency is detailed in a system in which a power consuming imaging mode is not activated until signaled by a preliminary mode signal. Paragraph 20 discloses that a timing signal of the sensor chip controls activation of the microcomputer. According to paragraph 21 of the cited reference, the reduced power consumption is obtained by an automatic switch from a first mode (preliminary scan) to a second mode (microcomputer activation). This stands in contrast to the applicants' present claims, which require a user controlled interface to switch from a first mode to a second mode. This element of the applicants' claim 1 (and claims 2-5 which depend on claim 1) is not disclosed in the cited art.

At least one element claimed by the applicants is not found in the cited reference. Given this fact, the present rejection should be reconsidered and withdrawn.

Section 103

Finally, the Office action found that applicants' claims 7-9 were rendered obvious by Shinohara. The applicants again request reconsideration in light of a review of the cited art.

An obviousness determination requires determining the scope and content of the prior art and ascertaining the differences between the cited art and the claims at issue. See *Graham v. John Deere Co.*, 148 USPQ 459 (S.C. 1966). When applying 35 U.S.C. § 103 in a finding of obviousness, the tenants of patent law require that the claimed invention be considered as a whole, that the cited references must suggest the desirability and thus the obviousness of making the

claimed combination, that the cited references must be viewed without the benefit of impermissible hindsight afforded by the claimed invention, and that the cited reference provide a reasonable expectation of success in practicing the claimed technology. See *Hodosh v. Block Drug Co., Inc.*, 229 USPQ 182, 187 (Fed. Cir. 1986).

The Office action notes that the cited art "do not teach a user establishing timing signals and a user interface allowing selection of the onboard timing means or outboard logic circuit". Given this fact, a *prima facie* case of obviousness has not been established. Elements of the applicants' claims are not found in the cited art. However, such teaching are required for a finding of obviousness.

Instead of teaching the applicants' claimed invention, the cited reference actually teaches away from the claimed method. Shinohara teaches a device designed to minimize energy consumption, as indicated in paragraph 21. This energy conservation goals is attained by periodic switching from a preliminary operation mode to a microcomputer controlled mode. Timing of this switching is effected by a timing circuit. Such periodic mode switching does not require a user input. Instead, the stated advantages are achieved only if an automated counter is used for imaging. This directly teaches away from the claimed user controlled method.

Under patent law, the cited references must be viewed without the benefit of impermissible hindsight afforded by the claimed invention. However, such hindsight is what is used to extend the cited reference to find the applicants' claims. This provides an independent reason for reconsideration of the instant rejection.

Conclusion

The applicants respectfully request reconsideration in light of the submitted remarks and amendments. A notice of allowance is earnestly solicited. If any matter relating to this case needs to be discussed please call our office at (408) 297-9733 between 9 a.m. and 5 p.m. Pacific time.

CERTIFICATE OF MAILING

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Asst. Commissioner for Patents, Washington, D.C. 20231

Signed: *Sally Azevedo*
Typed Name: Sally Azevedo
Date: December 10, 2002

Respectfully submitted,

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Version with Markings to Show Changes Made

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1. (amended) An improved CMOS integrated imager system having an array of pixel areas with at least one control area, wherein said pixel areas include a plurality of light collecting elements which each receive light and store electronic information in an amount indicative of an amount of light received during an integration period, with the control area having an internal timing element, wherein the improvement comprises:

[an] a user interface for receiving a plurality of data, address, and control signals, said interface [receiving] configured to receive from a user a mode signal for setting the system in one of a first operating mode or a second operating mode characterized in that the first operating mode uses the internal timing element to control timing operation of the system and the second operating mode bypasses the internal timing element to control timing operation of the system.

5. (amended) The imager system of Claim 3, wherein the external timing [block] element includes a memory and a DMA interface block.